

REMARKS

1 The Examiner objected to claims 1, 7, 14 and 19 due to a number of
informatities. Applicant has amended claims 1, 7, 14 and 19 according to the
Examiner's suggestions, which are appreciated. Accordingly, amended claims 1, 7, 14
5 and 19 are believed to be allowable and the Examiner is respectfully requested to
reconsider and allow the same.

 The Examiner rejected claims 1-12 under 35 U.S.C. § 102(b) as being anticipated
by U.S. Patent No. 2,144,875 to Forrest. Specifically, the Examiner states that each of
the structural limitations identified within claims 1-12 are taught or otherwise disclosed
10 by the Forrest. Similarly, claims 1 and 15 were rejected by the Examiner under 35
U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,187,344 to Porcello. While
the applicant respectfully disagrees with the Examiner's rejections, claim 1 has been
amended in an effort to expedite prosecution of the present application. Claim 1 is an
15 independent claim, from which claims 2-12 and 15 ultimately depend. Accordingly, the
Examiner's rejections are now believed to be moot in view of the applicant's
amendments, as discussed in greater detail herein below.

 Claims 13-20 were rejected by the Examiner under 35 U.S.C. § 103(a) as being
unpatentable over Forrest in further view of U.S. Patent No. 5,421,834 to Kester.
20 Specifically, the Examiner states that the Forrest patent teaches or otherwise discloses
each of the structural limitations found within claims 13-20 except for the limitations
relating to the hood and mittens. However, the Examiner argues that these limitations
are taught within the art, and more specifically by the Kester patent. The Examiner

1 states that it would have been obvious to one having ordinary skill in the art at the time
you derived your garment to have provided the Forrest garment with selectively
removable mittens and/or a hood as taught within the Kester patent. Claims 13-20 each
ultimately depend from claim 1, which has been amended, as discussed in greater
5 detail herein below. That amendment, and the amendment of other claims herein, are
believed to render the Examiner's rejections moot.

Claim 1 has been amended to specifically claim:

10 mitten means coupled to the interior portions of said first and second
sleeves for selectively receiving and at least partially covering a child's
hands without the necessity of uncoupling said mitten means from within
the interior portions of said first and second sleeves or passing the child's
hands completely through the open distal ends of said first and second
sleeves.

15 No such mitten means are disclosed or otherwise suggested by the prior art. Forrest
and Porcello do not disclose mitten means in any fashion. Kester teaches a pair of
gloves that are removably secured to pockets formed in the exterior of the sleeves of
the Kester jacket. A cord attaches each glove to the pocket. The Forrest coat and
Kester gloves do not provide a teaching that would lead a person of skill in the art to
develop a coat and mitten arrangement as claimed, on any objective basis.

20 There is insufficient structure identified within the limitation for performing the
recited function of "receiving and at least partially covering a child's hands without the
necessity of uncoupling said mitten means from within the interior portions of said first
and second sleeves or passing the child's hands completely through the open distal
ends of said first and second sleeves." Accordingly, the limitation must be construed
25 under 35 U.S.C. § 112(6). See, MPEP (2181-84). The Examiner may not summarily

1 conclude that Kester teaches gloves capable of performing the function if combined with
the Forrest jacket. Such conclusory statements, without the proper analysis, are
improper. In re Donaldson Co., 29 USPQ2d 1845 (Fed. Cir. 1994). Moreover, such a
statement would be incorrect. The Forrest jacket and Kester Gloves would not teach a
5 person of skill in the art the necessary structures or relational positioning of the
structures to form a jacket capable of performing the claimed function.

In order to meet a "means-plus-function" limitation, the prior art must: (1) perform
the identical function recited in the means limitation; and (2) perform that function using
the structure disclosed in the specification or an equivalent structure. Cf. Carroll Touch
10 Inc. v. Electro Mechanical Sys. Inc., 15 F.3d 1573, 1578, 27 USPQ2d 1836, 1840 (Fed.
Cir. 1994); Valmont Indus. Inc. v. Reinke Mfg. Co., 983 F.2d 1039, 1042, 25 USPQ2d
1451, 1454 (Fed. Cir. 1993). Johnston v. IVAC Corp., 885 F.2d 1574, 1580, 12
USPQ2d 1382, 1386 (Fed. Cir. 1989). Accordingly, in ascertaining that a "means-plus-
15 function" limitation is met by the prior art, an examiner must: (1) determine that the prior
art performs the identical function recited in the means limitation; (2) identify every
structure described in the patent specification that corresponds to the claimed function;⁴
(3) identify the structure in the prior art that performs the claimed function; (4) determine
if the structure in the prior art that performs the claimed function is the same as any
20 structure described in the patent specification that corresponds to the claimed function;
and if not (5) determine if the structure in the prior art that performs the claimed function

⁴ Structure disclosed in the specification is corresponding structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim. Medtronic, Inc. v. Adv. Cardiovascular Sys., Inc., 248 F.3d 1303, 1311, 58 USPQ2d 1607, 1613 (Fed. Cir. 2001).

1 is equivalent to any structure described in the patent specification that corresponds to
the claimed function.

5 Manual of Patent Examining Procedure (MPEP) § 2183 provides that if the
examiner finds that a prior art element (A) performs the function specified in the claim,
(B) is not excluded by any explicit definition provided in the specification for an
equivalent, and (C) is an equivalent of the means plus function limitation, the Examiner
should provide an explanation and rationale in the Office action as to why the prior art
element is an equivalent.⁵

10 In this case, the specification teaches a pair of mittens coupled within the interior
of the sleeves. The Figures clearly indicate the correct positioning and manner of
securing the mittens that permits the structures to perform the recited function. The
prior art, or any combination thereof, are not capable of performing the recited function,
let alone performing the function with the same or equivalent structures. Accordingly,
15 claim 1 is believed to be patentably distinct from the prior art. Claims 2-20 ultimately
depend from claim 1 and are believed to be allowable for at least the reasons set forth
with respect to claim 1.

20 Claim 13 was amended to include the limitation that the mitten means are formed
to have peripheral edges that define open ends of said mitten means and that at least a

⁵ The four tests set forth in MPEP § 2183 for determining whether or not a prior art element is an
equivalent to the corresponding element disclosed in the specification are (A) the prior art element
performs the identical function specified in the claim in substantially the same way, and produces
substantially the same results as the corresponding element disclosed in the specification; (B) a person of
ordinary skill in the art would have recognized the interchangeability of the element shown in the prior art
for the corresponding element disclosed in the specification (C) there are insubstantial differences
between the prior art element and the corresponding element disclosed in the specification; and (D) the
prior art element is a structural equivalent of the corresponding element disclosed in the specification.

1 portion of the peripheral edges are directly coupled to the interior portions of the first
and second sleeves for selectively covering a child's hands when said child wears the
garment. The prior art does not teach or otherwise suggest such structural limitations.
Therefore, claim 13 is believed to be allowable.

5 Claim 14 specifically states that the mitten means are comprised of first and
second mittens that are each formed from a single panel of flexible fabric. Although the
Examiner states that the Kester gloves are formed from a single panel of fabric, no such
teaching or disclosure can be found within the reference. Moreover, Claim 14 has been
amended to claim the limitation that the construction of the mittens provides a single
10 hand compartment within each mitten, without forming separate compartments for
thumbs or fingers. Due to the location of the mittens within the sleeves, such
construction greatly assists the user in placing a child within the garment, without
hunting for individual pockets for fingers or worrying that several fingers are cramped
15 into a single finger pocket, causing discomfort. A person of skill in the art will also
recognize the ease with which the claimed structure can be constructed. No such
claimed structure is taught or otherwise disclosed within the prior art. Accordingly, claim
14 is believed to be allowable.

20 In determining the difference between the prior art and the claims, the question
under 35 U.S.C. § 103 is not whether the differences themselves would have been
obvious, but whether the claimed invention as a whole would have been obvious.
Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). A
prior art reference and the claimed invention must be considered in their entireties.

1 Distilling an invention down the "gist" or "thrust" of an invention disregards the
requirement of analyzing the subject matter "as a whole." W.L. Gore & Associates, Inc.
v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *Cert. denied*, 469 U.S.
851 (1984).

5 The mere fact that the references can be modified does not render the resulting
modified structure obvious unless the prior art also suggests the desirability of the
combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). "A
statement that modifications of the prior art meet the claimed invention and would have
been 'well within the ordinary skill in the art at the time the claimed invention was made
10 because the references relied upon teach that all aspects of the claimed invention were
individually known in the art' is not sufficient to establish a *prima facie* case of
obviousness without some objective reason to combine the teachings of the
references." Ex parte Leavengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

15 Just because a structural detail is simple and known for other purposes, does not
render it "obvious". In re Kotzab, 217 F.3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000), the
Federal Circuit Court of Appeals decided that the control of multiple valves by a single
sensor rather than by multiple sensors was a technologically simple concept. However,
the Federal Circuit held that there was no finding as to the specific understanding or
20 principal within the knowledge of the skilled artisan that would have provided the
motivation to use a single sensor as the system to control more than one valve. The
claimed structural design of applicant's coat is an example of such a patentable
structure born from a technologically simple concept.

1 In light of the above amendments and remarks, applicant asserts that claims 1-20
are in condition for allowance. Applicant respectfully requests reconsideration and
allowance of the same.

5 No fees or extensions of time are believed to be due in connection with this
amendment; however, please consider this a request for any extension inadvertently
omitted, and charge any additional fees to Deposit Account No. 502093.

Respectfully submitted,



10 SHANE M. NIEBERGALL
Registration No. 44,974
THOMTE, MAZOUR & NIEBERGALL
Attorneys of Record

2120 S. 72nd Street, Suite 1111
Omaha, NE 68124
(402) 392-2280

15 CERTIFICATE OF MAILING

I hereby certify that the original of this AMENDMENT for JOI MAHON, Serial No.
10/806,887, was mailed by first class mail, postage prepaid, to Mail Stop Amendment,
20 Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 7th day
of July, 2005.


SHANE M. NIEBERGALL